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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,110	07/11/2001	William Holm	0104-0353P	8194
2292	7590	04/19/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			PURVIS, SUE A	
			ART UNIT	PAPER NUMBER
			1734	

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/902,110	Applicant(s) HOLM ET AL.	
	Examiner Sue A. Purvis	Art Unit 1734	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

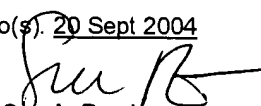
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 20-26,32-39 and 56-80.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
Please see the attached response.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s): 20 Sept 2004
13. ☐ Other: _____.


Sue A. Purvis
Primary Examiner
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Response to Amendment

1. The amendment has not because I disagree with applicant's assertion that entering the amendment would simplify the issues for appeal. Furthermore, entering the amendment would force the examiner to re-examine those claims and subsequent claims which depend therefrom and change the prior rejection.

Response to Arguments

2. Applicant's arguments filed 31 March 2005 have been fully considered but they are not persuasive.

3. The majority of applicant's arguments are drawn to the claims as amended, however, as stated above, the amendment has not been entered, nonetheless I will address the arguments as they stand with respect to claims 20, 32, 56 and 57.

4. On page 13 of the Response dated 31 March 2005, applicant argues that with "the structure according to the present invention, it is possible to inspect more than one location on a substrate after completing of an application of viscous medium at a plurality of locations." This may be the case, but applicant fails to point out what structure allows this feature and how the structure of the apparatus defined in the applicant's claim is different from the structure in the prior art Banno et al. (US Patent No. 6,511,545 B2) (hereafter "Banno"). Banno includes an application means, an inspection means, a processing means, and a correction means as set forth in the previous office action which is what is set forth in claim 20. Claim 57 includes the features where the processing means includes "estimating means for estimating the time required for performing corrective action for each of the determined errors" and "calculating means for calculating the overall time required for corrective action of all determined errors." However, as addressed in the previous office action, the processing means in Banno includes a process for determining application errors by which corrective action is undertaken. While there is no mention in Banno estimating the time for performing the corrective action or calculating the overall time required for the action, the processor in Banno is capable of being programmed to achieve this and as stated in the Office Action, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the apparatus of Banno be capable of such an operation, because the processor means of Banno controls the corrective actions and skilled artisan would appreciate how to modify the processor to achieve these functions recited by the claim.

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5. On pages 14 and 15 of the applicant's response, applicant goes on to argue that the inspection in the instant inventions occurs "after completion of the application at the plurality of locations" and inspection happens "at more than one of the plurality of locations." These are functional steps and do not differentiate applicant's apparatus from the prior art apparatus in Banno. While, Banno does not perform in the same way functionally as the present invention, the apparatus of Banno includes all the same structural features as the instant invention. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). "[A]pparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

6. On pages 15 through 18 of the applicant's response, applicant argues that a *prima facie* case of obviousness has not been established because motivation was not located in the prior art to modify the reference relied on. By reading on the MPEP, the applicant would note that §2144 clarifies that "rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). It is general knowledge available to one of ordinary skill in the art that the examiner has relied on. The examiner has not relied on "common sense" or "common knowledge" as suggested by the applicant, but on knowledge generally available to one of ordinary skill in the art.

7. Furthermore, applicant's reliance on *In re Lee* on page 19, as support for their arguments is misguided, because *In re Lee* is for a combination of references, while in this case it is Banno alone which is used for rejecting claims 56 and 57, thus the analysis used by the court is not on the mark. Furthermore, applicant's claims are apparatus claims which are treated differently than method claims, the type of claims discussed in *In re Lee*. The

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prior art used in rejecting apparatus needs to have all the structural limitations of the claims, but the structure of the prior art does not need to perform all the functional steps in the claims, the structure only needs to be capable of performing the functional steps. The portion of *In re Lee* that the examiner did find illuminating was as follows: "In finding the relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies." *In re Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002). Here, the examiner has set forth the knowledge relied on and it is clearly articulated in the record.

8. In response to applicant's arguments on page 20, a processor is a computer which implicitly has an internal time element, and time is an essential part of any control mechanism, thus the processor in Banno includes the essential elements for the control scheme and is capable of being altered to achieve the limitations of claims 56 and 57. It is again submitted that recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

9. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Applicant's arguments with respect to using hindsight on page 20 rely on their desire for the examiner to include the functional elements of their invention in the apparatus claim, which I have refused to do.

10. As for applicant's arguments on pages 20 and 21, the applicant is suggesting that "the Examiner must first provide evidence that one having ordinary skill in the art was

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aware of a problem before the Examiner can modify a prior art reference to arrive at the present invention." Again, the case law cited by the applicant is not really on point as the Court reversed, finding that applicant's claim was not obvious not only because it went beyond prior art by discovering the source of the problem, which was not obvious, but also because the prior art actually taught away from the combination employed by the claim, and the commercial success of the applicant's device was an important indicia of unobviousness. The situation here is completely different, because the applicant's claims are for an apparatus for providing a viscous medium to a substrate, same is true in Banno. The Banno device includes all the structural features of applicant's claims, including a sophisticated processor capable of being programmed as set forth in claims 56 and 57.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sue A. Purvis
Primary Examiner
Art Unit 1734

SP
April 15, 2005